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EXAMINER

EDELMAN, B

ART UNIT

PAPER NUMBER

2153

DATE MAILED:

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

NW

Office Action Summary

Application No.

09/782,380

Applicant(s)

LAZARIDIS ET AL.

Examiner

Bradley Edelman

Art Unit

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.

- 18) ☒ Interview Summary (PTO-413) Paper No(s). _____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

DETAILED ACTION

Requirement for Information Under 37 C.F.R. 1.105

1. Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.
2. The information is required to enter in the record the art suggested by the applicant as relevant to this examination in the Petition to Make Special Because of Actual Infringement Under 37 CFR 1.102 filed on May 4, 2001. In particular, the following material, declared to be known by applicant, must be disclosed:
 - a. Evidence, literature, and/or any other relevant material relating to the infringing device and method known by applicant to be actually on the market
 - b. A description and/or evidence that rigidly compares the alleged infringing device and method with the claims of the present patent application, as declared by applicant.
3. This information is required to identify in the record the art suggested by the applicant as relevant to this examination in the Petition to Make Special.

In response to this requirement, please provide or disclose any information known to be pertinent to the present application, as disclosed by applicant in the Petition to Make Special.

4. The fee and certification requirements of 37 C.F.R. 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 C.F.R. 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 C.F.R. 1.105 are subject to the fee and certification requirements of 37 C.F.R. 1.97.
5. In responding to those requirements that require copies of documents, where the document is a bound text or a single article over 50 pages, the requirement may be met providing copies of those pages that provide the particular subject matter indicated in the requirement, or where such subject matter is not indicated, the subject matter found in applicant's disclosure.
6. The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where the applicant does not have or

Art Unit: 2153

cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained will be accepted as a complete response to the requirement for that item.

7. This requirement is subject to the provisions of 37 C.F.R. §§ 1.134, 1.135, and 1.136 and has a shortened statutory period of 2 months. EXTENSIONS UNDER THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-30, and 42-47 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6,219,694. Although the conflicting claims are not identical, they are not patentably distinct from each other for the following reasons:

Claim 1 of the '694 patent contains all of the limitations of claims 1 and 2 of the present application. It would have been obvious to a person having ordinary skill in the art to leave out certain steps of '694 claim 1 in order to simplify the claimed system.

Furthermore, it would have been obvious to include multiple data communication devices, as claimed in the present invention but not claimed in the '694 patent, so that multiple users could use the system.

Claim 2 of the '694 patent contains all of the limitations of claim 3 of the present application.

Claim 3 of the '694 patent contains all of the limitations of claim 4 of the present application.

Claim 4 of the '694 patent contains all of the limitations of claim 5 of the present application.

Claim 5 of the '694 patent contains all of the limitations of claim 7 of the present application.

Claim 6 of the '694 patent contains all of the limitations of claim 8 of the present application.

Claim 7 of the '694 patent contains all of the limitations of claim 6 of the present application.

Claim 8 of the '694 patent contains all of the limitations of claim 9 of the present application.

Claim 9 of the '694 patent contains all of the limitations of claim 10 of the present application.

Claim 10 of the '694 patent contains all of the limitations of claim 11 of the present application.

Claim 11 of the '694 patent contains all of the limitations of claim 12 of the present application.

Claim 12 of the '694 patent contains all of the limitations of claim 13 of the present application.

Claim 13 of the '694 patent contains all of the limitations of claim 14 of the present application.

Claim 14 of the '694 patent contains all of the limitations of claim 15 of the present application.

Claim 15 of the '694 patent contains all of the limitations of claim 16 of the present application.

Claim 16 of the '694 patent contains all of the limitations of claim 17 of the present application.

Claim 17 of the '694 patent contains all of the limitations of claim 18 of the present application.

Claim 20 of the '694 patent contains all of the limitations of claim 19 of the present application.

Claim 21 of the '694 patent contains all of the limitations of claim 20 of the present application.

Claim 18 of the '694 patent contains all of the limitations of claim 21 of the present application.

Claim 19 of the '694 patent contains all of the limitations of claim 22 of the present application.

Claim 1 of the '694 patent contains all of the limitations of each of claims 24, 25, 26, 27, 28, 29, 30, 42, 43, 44, 45, and 46 of the present application. Although claim 1 of the '694 patent does not cite a "common e-mail account" or "packaging the first message into an electronic message addressed to the host system", both of these steps are inherent in claim 1 of the '694 patent (the "common e-mail account" is inherent since both devices in claim 1 of the '694 patent "share the first address", and the "packaging" is an inherent step in the process of "transmitting the reply message [from the mobile data communication device] to the host system").

Claims 1 and 14 of the '694 patent contain all of the limitations of claim 47 of the present application (since a pager, claimed in claim 14 of the patent, is necessarily wireless, as claimed in claim 47 of the application; since storing the messages at the mobile device, as claimed in claim 47 of the application is inherent in the mobile device claimed in claim 1 of the patent; and since components and transmitters for the wireless communication claimed in claim 47 of the application are inherent in the invention claimed in claim 1 of the patent as well).

In considering claim 23 of the present application, although the claimed feature of including an indication that a message originated from the mobile device is not claimed in the '694 patent, the inclusion of this feature would have been obvious to a person having ordinary skill in the art, so that important people, such as the mobile device user's family, friends, or boss, for instance, would know when the user is away from the office.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 35-37 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In considering claims 35-37, none of the claimed "application service provider", "web-based email server", or "web-based personal information manager" were described in the specification so as to enable one skilled in the art to make the invention as claimed in claims 35-37.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application

Art Unit: 2153

by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

2. Claims 1-3, 6, 9, 10, 16, 24-30, and 42-46 are rejected under 35 U.S.C. 102(e) as being anticipated by Staples et al. (U.S. Patent No. 5,764,639, hereinafter "Staples").

In considering claim 1, Staples discloses a method, system, and computer program product for redirecting data items between a host system (corporate office) and one or more mobile communication devices (102), comprising the steps of:

receiving data items directed to a common address associated with the host system (col. 23, lines 28-30);

continuously redirecting the data items to a mobile communication device (col. 23, lines 14-19); and

receiving the data items sent from the mobile communication device (col. 23, lines 24-28);

wherein data items generated at either the host system or the mobile communication device share the common address as an address from which data items originated (col. 6, lines 20-40; col. 21, lines 5-18; col. 23, lines 2-13; col. 24, lines 54-59).

In considering claim 2, Staples further discloses the claimed redirection event and trigger, and continuously redirecting the data items to the mobile device in response to the trigger (col. 17, lines 1-17).

In considering claim 3, Staples further discloses storing information regarding the configuration of the mobile devices at the host system (col. 18, lines 2-10).

In considering claim 6, Staples further discloses addressing the received data items using a sender address and a receiver address (such addressing is inherent in e-mail; col. 6, lines 19-26), further comprising the steps of:

determining whether the receiver address is associated with a mobile communication device, and if the receiver address is associated with the mobile device, then determining a network address of the mobile device and repackaging the data items into an electronic envelopes and displaying the items at the mobile device using the sender address and the receiver address, so that it appears as though the mobile device is the host system (col. 5, lines 37-47; col. 7, lines 28-33; col. 21, lines 31-50; col. 6, lines 19-44, wherein the "network address" and the "repackaging" are inherent in sending the message to the remote device).

In considering claim 9, Staples further discloses that the redirection events include external events, internal events, or networked events (col. 17, lines 1-17).

In considering claim 10, Staples further discloses that the event is a message from the mobile device to start redirection (col. 17, lines 1-17).

In considering claim 16, Staples further discloses that the mobile device can receive both voice and non-voice messages (col. 7, lines 19-27).

In considering claim 24, Staples further discloses a computer system for redirecting messages from a mobile data communication device, comprising:

- a host system (corporate office) capable of sending and receiving messages;
- a common e-mail account having an electronic address, wherein the account is associated with the host system and the mobile device; and
- a redirector component that forwards e-mail messages from the host system to the mobile device and replies from the mobile device to the host system, wherein the replies are addressed using the common e-mail address (col. 23, lines 2-30; sending replies is inherent in the e-mail art).

In considering claims 25 and 26, Staples further discloses that the reply messages (inherent) can be sent from the mobile device or the host (col. 22, lines 40-47).

In considering claims 27-30, and 46, all limitations of these claims are disclosed by Staples in the same sections cited above with regard to claims 1, 2, and 24-26.

In considering claims 42 and 45, Staples explicitly discloses the steps of:

Art Unit: 2153

a user creating a first message at a mobile data communication device, wherein the first message is addressed to a message recipient and from a host system ("email", col. 23, lines 12-13);

packaging the first message into an electronic envelope addressed to the host system and transmitting the electronic envelope to the host system (this is inherent since the message is first sent to the host system – col. 22, line 48 – col. 23, line 14); and

recovering the first message from the envelope at the host system and transmitting the first message to the message recipient so that the user of the mobile data communication device appears to have created the first message at the host system (col. 22, lines 2-13).

In considering claim 43, reply messages are inherent in the e-mail art.

In considering claim 44, Staples discloses that the message is an original message generated at the mobile device (col. 23, lines 11-13).

3. Claims 31, 32, 34, 37, 38, and 41 are rejected under 35 U.S.C. 102(e) as being anticipated by Ulrich et al. (U.S. Patent No. 6,052,735, hereinafter, "Ulrich").

In considering claim 31, Ulrich discloses a method of redirecting data items between a host system (desktop computer 4) and one or more mobile communication devices (mobile device 3), comprising the steps of:

receiving data items directed to a common address associated with the host system (col. 4, lines 4-8, "electronic mail");

copying the one or more data items, and sending the data items to a mobile communication device (col. 4, lines 53-59); and

receiving the data items sent from the mobile communication device (col. 4, lines 53-59);

wherein data items generated at either the host system or the mobile communication device share the common address as an address from which data items originated (col. 11, line 59 – col. 12, line 7, wherein both devices are using the same e-mail account).

In considering claim 32, Ulrich discloses a method of mirroring data items between a host system (4) and one or more mobile communication devices (3) comprising the steps of:

receiving one or more incoming data items directed to a common address associated with a user account of the host system (col. 4, lines 4-8, "electronic mail");

copying the one or more data items, and sending the data items to a mobile communication device (col. 4, lines 53-59); and

receiving at the host system outgoing data items sent from the mobile communication device, and storing at the host system the data items sent from the mobile communication device, wherein data items generated at either the host system or the mobile communication device share the common address as an address from

Art Unit: 2153

which data items originated (col. 4, lines 53-59; col. 11, line 59 – col. 12, line 7, wherein both devices are using the same e-mail account).

In considering claim 34, Ulrich further discloses that the host is a desktop networked computer (desktop computer 4).

In considering claim 38, Ulrich further discloses that the common address is an e-mail address (col. 2, lines 62-64).

In considering claim 41, the system taught by Ulrich would inherently package the data into electronic envelopes prior to redirecting them, and unpackaging from electronic envelopes the data items sent from the mobile device (col. 5, lines 7-14, "wireless modem" or "CDPD").

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Staples.

In considering claim 23, although the system taught by Staples teaches substantial features of the claimed invention, it fails to disclose adding a descriptor to

Art Unit: 2153

the data items generated at the mobile device to indicate that the data item originated from the mobile device instead of the host system. Nonetheless, the inclusion of this feature would have been obvious to a person having ordinary skill in the art, so that important people, such as the mobile device user's family, friends, or boss, for instance, would know when the user is away from the office.

6. Claims 33, 35-37, 39, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ulrich.

In considering claim 33, Ulrich does not disclose that the host system is a corporate network server. Nonetheless, it would have been obvious to a person having ordinary skill in the art to use the system taught by Ulrich for a corporate network server host system so that travelling corporate executives remain synchronized with their business at all times.

In considering claim 35, Ulrich does not disclose that the host system is an application service provider. Nonetheless, it would have been obvious to a person having ordinary skill in the art to use the system taught by Ulrich for an application service provider host system so that the applications stored on sent to the user's PDA can remain up to date.

In considering claim 36, Ulrich does not disclose that the host system is a web-based email server. it would have been obvious to a person having ordinary skill in the

art to use the system taught by Ulrich for a web-based email server host system so that the email data stored on the user's PDA can be synchronized with the data stored at the host system for users anywhere in the world.

In considering claim 37, Ulrich further discloses that the host system is a personal information manager (col. 1). However, Ulrich does not disclose that the PIM is a web-based PIM. Nonetheless, it would have been obvious to use the synchronization system taught by Ulrich for web-based PIMs so that the PIM data stored on the user's PDA can be synchronized with the data stored at the host system for users anywhere in the world.

In considering claims 39 and 40, Ulrich does not explicitly disclose that messages sent between the host and the mobile device are encrypted and decrypted. Nonetheless, Examiner takes official notice that it is well known for messages sent over a wireless medium to be encrypted and decrypted to prevent security breaches. Therefore, it would have been obvious to include encryption and decryption for messages sent between the devices taught by Ulrich so that the messages could not be easily pirated and read by unauthorized users.

7. Claims 4, 5, 15, and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Staples, in view of Ulrich.

In considering claim 4, the system taught by Staples inherently stores configuration information about the mobile device, the information including the network address of the mobile device (this information would be necessary in order for the host to send messages to the mobile device). However, Staples does not discuss how attachments to e-mail messages are processed, and thus does not disclose that the configuration information includes an indication of the types of message attachments that the mobile device can receive and process. Nonetheless, the use of such information for processing of e-mail attachments at mobile devices is well known, as evidenced by Ulrich. In a similar art, Ulrich discloses a system for sending e-mails with attachments to mobile devices (col. 11, lines 59-63), wherein the types of attachments that the mobile device can receive are specified at the host system (col. 14, lines 7-31; wherein the "desktop" is the host). It would have been obvious to include such an attachment processing system as taught by Ulrich in the system taught by Staples, so that attachments sent to the mobile PDA disclosed by Staples, but which are not initially compatible with the device, can still be viewed by the user.

In considering claim 5, although the system taught by Staples and Ulrich teaches substantial features of the claimed invention, it fails to explicitly disclose configuration information including the indication of the type of the mobile communication device. Nonetheless, it would have been obvious if not inherent to include this information with the user profile information disclosed by Ulrich (col. 14, lines 7-19) so that attachments

Art Unit: 2153

which cannot be accepted by a specific type of device (i.e. hand-held pdas using different operating systems) can still be viewed by the user.

In considering claim 15, Staples further discloses that the mobile device can be a hand-held palm-top computer, or a laptop computer, or a mobile telephone (col. 4, lines 22-29). However, Staples does not explicitly state that the laptop or PDA can be wireless, or that the mobile telephone can have data message capabilities. However, Staples does state, "the remote computer system 102 used by the remote user may comprise either an analog modem 184 or an ISDN terminal adapter 182, *or another type of communication device.*" Wireless laptops and pdas, and data message-enabled mobile telephones are well known in the art, as evidenced by Ulrich. In a similar art, Ulrich describes a system for forwarding messages between a mobile device and a host computer, wherein the remote computer can be a wireless laptop or pda (Abstract; col. 7, lines 21-30). Thus given the teaching of Ulrich, it would have been obvious to a person having ordinary skill in the art for the "another type of communication device" described by Staples to be a wireless laptop or pda, as described by Ulrich, so that road users could avoid the hassle of plugging in wires every time they want to connect to the network.

In considering claim 47, all of the limitations of the claim are disclosed in the previously cited sections of Staples, except for the limitation that the mobile device is wireless. Staples only explicitly discloses that the mobile device can be a hand-held

palm-top computer, or a laptop computer, or a mobile telephone (col. 4, lines 22-29).

However, Staples does not explicitly disclose that the laptop or PDA can be wireless, or that the mobile telephone can have data message capabilities. However, Staples does state, "the remote computer system 102 used by the remote user may comprise either an analog modem 184 or an ISDN terminal adapter 182, *or another type of communication device.*" Wireless laptops and pdas, and data message-enabled mobile telephones are well known in the art, as evidenced by Ulrich. In a similar art, Ulrich describes a system for forwarding messages between a mobile device and a host computer, wherein the remote computer can be a wireless laptop or pda (Abstract; col. 7, lines 21-30). Thus given the teaching of Ulrich, it would have been obvious to a person having ordinary skill in the art for the "another type of communication device" described by Staples to be a wireless laptop or pda, as described by Ulrich, so that road users could avoid the hassle of plugging in wires every time they want to connect to the network.

8. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Staples in view Ulrich, and further in view of Tang et al. (U.S. Patent No. 5,630,060, hereinafter "Tang").

In considering claim 7, Ulrich further discloses:

determining whether each data item includes an attachment, and determining the type of attachment, and determining whether the mobile data communication device can receive and process such attachments (col. 14, lines 7-19).

However, neither Ulrich nor Staples discloses:

if the mobile device can receive and process the attachments, then redirecting the attachments to the mobile data communication device, and if not, then redirecting the attachments to an external machine that is compatible with the attachment.

Ulrich instead discloses that if the mobile device can receive and process the attachments, then redirecting the attachments to the mobile data communication device, but if not, then *converting* the attachments at the host so that they can be viewed at the mobile device (col. 14, lines 7-19). Nonetheless, the process of forwarding messages which cannot be processed at a specific device to a different device which can process the messages is well known, as evidenced by Tang. In a similar art, Tang describes an e-mail forwarding system wherein "multimedia components" or attachments which are part of an e-mail message, are sent over a medium, and ultimately to a device which is compatible with the attachment format (col. 1, lines 52-54; col. 1, line 67 – col. 2, line 19; col. 3, lines 1-4; col. 7, lines 19-25). Given the teaching of Tang, a person having ordinary skill in the art would have readily recognized the desirability and advantages of sending message attachments to compatible machines, as taught by Tang, in the message redirection system taught by Staples and Ulrich so that important images, sound files, or video sequences attached to an e-mail, and which are needed immediately for a business executive using the PDA disclosed by Staples (col. 4, lines 23-27), but which cannot be displayed by the PDA, can still be immediately received by the business executive. Therefore, the claimed invention would have been obvious over Staples and Ulrich, in view of Tang.

In considering claim 8, Tang further discloses that the attachment can be a sound file (col. 4, Table 1).

9. Claims 17-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Staples, in view of Narasimhan et al. (U.S. Patent No. 6,073,165, hereinafter, "Narasimhan").

In considering claim 17, although the system taught by Staples teaches substantial features of the claimed invention, it fails to disclose the inclusion of a preferred list for limiting redirecting to senders on a preferred list. Nonetheless, the use of preferred lists for filtering data items is well known, as evidenced by Narasimhan. In a similar art, Narasimhan discloses a system for redirecting messages from a host system (source server 103) to a portable data communication device (receiver 133; col. 4, lines 1-40), wherein a message filter is applied to the redirected messages (col. 5, lines 3-17), the filter including a preferred list ("messages sent by a particular individual", col. 5, lines 13-17). It would have been obvious to a person having ordinary skill in the art to include such a preferred list in any e-mail forwarding system so that only the most important messages are sent to the user, thus saving bandwidth and saving time for the user.

In considering claim 18, Narasimhan further discloses that the user can add and subtract senders from the preferred list (col. 5, lines 13-17).

In considering claim 19, Narasimhan further discloses that the list is activated or deactivated at the host system (server 103 maintains the message processing).

In considering claim 20, the combined teaching of Staples and Narasimhan further discloses that the mobile device could transmit a message to the host system to activate or deactivate the list (since a user at the "virtual presence" mobile device would be able to program the host system just as a user at the host system itself).

In considering claim 21, Narasimhan further discloses that the user can add and subtract senders from the preferred list by configuring the host system (col. 5, lines 13-17).

In considering claim 22, the combined teaching of Staples and Narasimhan further discloses that the mobile device could transmit a message to the host system to add or subtract senders from the list (since a user at the "virtual presence" mobile device would be able to program the host system just as a user at the host system itself).

10. Claims 1, 2, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ulrich, in view of Kaufman (U.S. Patent No. 6,034,621).

In considering claim 1, Ulrich discloses a method for redirecting data items between a host system (desktop 4) and one or more mobile communication devices (mobile device 3), comprising the steps of:

receiving data items directed to a common address associated with the host system ("electronic mail", col. 4, lines 4-7);

redirecting the data items to a mobile communication device (col. 4, lines 53-59);
and

receiving the data items sent from the mobile communication device (col. 11, line 59 – col. 12, line 7);

wherein data items generated at either the host system or the mobile communication device share the common address as an address from which data items originated (both devices use the same email account).

However, Ulrich does not disclose that the data items are continuously redirected. Nonetheless, continuous redirection of data items from a PIM program on a personal computer to a PIM program on a PDA is well known, as evidenced by Kaufman. In a similar art, Kaufman discloses a system for synchronizing data items between a host system (PC 600 system) and a remote device (wireless remote PDA; col. 3, lines 48-58), wherein data items can be continuously redirected (col. 4, lines 31-35). Thus, given the teaching of Kaufman, a person having ordinary skill in the art would have readily recognized the desirability and advantages of continuously updating the data items taught by Ulrich, to minimize the amount of data transfer necessary between data files at any one time (see Kaufman, col. 4, lines 38-40).

Art Unit: 2153

In considering claim 2, Kaufman further discloses a redirection event, generating a trigger in response to the event, and continuously redirecting the data items to the mobile device in response to the trigger (col. 4, lines 28-30).

In considering claim 9, Kaufman further discloses that the event can be an internal event, external event, or network event (col. 4, lines 28-30).

11. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ulrich and Kaufman in view of Kuki (EP Patent No. 772,327 A2, hereinafter "Sharp").

In considering claim 11, although the system taught by Ulrich and Kaufman discloses various events which can trigger redirection and replication of data elements, it fails to disclose a calendar alarm as one of the events. Nonetheless, the use of calendar alarms to trigger redirection of data between a PC and a PDA is well known, as evidenced by Sharp ("appointment designation", col. 8, lines 3-6; see also Abstract). Thus, given the teaching of Sharp, a person having ordinary skill in the art would have readily recognized the desirability and advantages of using a calendar alarm to trigger redirection or messages, as taught by Sharp, in the wireless synchronization system taught by Ulrich and Kaufman, so that a user can schedule regular synchronization sessions for larger sets of data without having to remember to push a synchronization button (see Kaufman, col. 4, lines 45-60). Therefore, it would have been obvious to include scheduled forwarding, as taught by Sharp, in the synchronization system taught by Ulrich and Kaufman.

12. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ulrich and Kaufman, in view of Rakavy et al. (U.S. Patent No. 5,913,040, hereinafter, "Rakavy").

In considering claims 13 and 14, the system taught by Ulrich and Kaufman fails to disclose the trigger event including a screen saver or a keyboard timeout signal. Nonetheless, the use of screen savers and keyboard timeout signals as trigger events is well known, as evidenced by Rakavy. In a similar art, Rakavy discloses a system for triggering a network communication between a home computer and a remote computer upon activation of a screen saver or completion of a keyboard timeout signal (col. 7, line 63 - col. 8, line 3). Given the teaching of Rakavy, it would have been obvious to a person having ordinary skill in the art to activate replication or redirection of data elements in the system taught by Ulrich and Kaufman, upon activation of a screen saver or completion of a keyboard timeout so that the PC and PDA only use valuable processing time for synchronizing larger files when at least the PC would have otherwise been idle (thereby helping to prevent processing overloads).

13. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ulrich and Kaufman, further in view of Moon et al. (U.S. Patent No. 6,138,146, hereinafter "Moon").

In considering claim 14, although the combined teaching of Ulrich and Kaufman discloses substantial features of the claimed invention, it fails to explicitly disclose networked events for redirection including messages sent from computer systems other

Art Unit: 2153

than the mobile data communication device which are connected to the host system via a wired network. Nonetheless, sending messages from any computer to activate a redirection program at a host is well known, as evidenced by Moon. In a similar art, Moon discloses a system for forwarding messages at a host to a mobile communication device, wherein the forwarding system can be activated or deactivated by sending an e-mail to the host (col. 6, lines 26-38). Although the e-mail in the system taught by Moon is sent from the mobile device, Examiner takes official notice that it is well known that e-mail messages can be sent from Internet-enabled devices on any network. A person having ordinary skill in the art would have readily recognized the desirability and advantages of allowing control of the forwarding program from any networked computer so that battery power can be saved at the mobile device while still allowing remote control of the forwarding program. Therefore, it would have been obvious to allow control of the forwarding program disclosed by Ulrich and Kaufman from any network device, as suggested by Moon.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

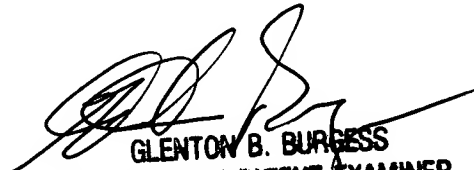
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley Edelman whose telephone number is (703) 306-3041. The examiner can normally be reached on Monday to Friday from 8:30 AM to 5:00 PM.

Art Unit: 2153

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on (703) 305-4792. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7201.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-3900.

BE
June 19, 2001



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